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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/849,793	05/04/2001	Shyh-Mei F. Ho	SVL920010041US1/3493P	1989
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IBM ST-SVL SAWYER LAW GROUP LLP 2465 E. Bayshore Road, Suite No. 406 PALO ALTO, CA 94303			EXAMINER PRICE, NATHAN E	
			ART UNIT 2194	PAPER NUMBER
			NOTIFICATION DATE 09/16/2008	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patent@sawyerlawgroup.com

<b>Office Action Summary</b>	<b>Application No.</b> 09/849,793	<b>Applicant(s)</b> HO ET AL.	
	<b>Examiner</b> NATHAN PRICE	<b>Art Unit</b> 2194	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 13-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 13-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>06/26/2008</u> .  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Claims 1 and 13 – 17 are pending.
2. This Office Action is in response to communications received 22 July 2008. Previous objections and rejections not included in this Office Action have been withdrawn.

### ***Continued Examination Under 37 CFR 1.114***

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 22 July 2008 has been entered.

### ***Response to Arguments***

4. Applicant's arguments with respect to claims 1 and 13 – 17 have been considered but are not persuasive or are moot in view of the new ground(s) of rejection.
5. Applicant argues that although Ben-Shachar teaches the end user application can be a web browser, the reference fails to teach the end user application can be a

SOAP application or a Java application. However, the claim recites the end user application being any of a web browser, a SOAP application or a Java application. Therefore, teaching any of the three embodiments teaches the recited limitation.

6. Regarding the claimed screen formatting, Ben-Shachar fails to teach "...capturing with 3270 screen formatting..." as previously claimed. See the current rejection regarding rejection of the currently amended limitation.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1 and 13 – 17 contain the trademark/trade names SOAP, Java and 3270. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade

name is used to identify/describe formats and languages and, accordingly, the identification/description is indefinite.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 1 and 13 – 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ben-Shachar (US 5,761,656) in view of Deborin (see PTO-892 mailed 24 August 2007).

9. It is noted that in the event that the runtime middleware of claim 1 part b) is an application, then the web application server and the connector are not required. Since part e) further specifies features of the connector, a reference teaching the runtime middleware is an application is not required to teach the features recited in part e) in order to disclose an embodiment the claimed method. However, part e) of the claim is addressed in this rejection.

Art Unit: 2194

10. As to claim 1, Ben-Shachar discloses a method of processing an application request on an end user application and an application server including a runtime middleware (abstract; col. 5 lines 2 -16), the method comprising:

a) initiating the application request on the end user application in a first language with a first application program wherein the end user application is a web browser, a SOAP application or a Java application (col. 5 lines 6 - 33);

b) transmitting the application request to the server and converting the application request from the first language of the first end user application to a form for the language running on the application server (col. 5 lines 3 - 12), wherein the end user application is connected to the application server through a runtime middleware that is an application or a web application server, the web application server comprising a connector (col. 5 lines 2 - 16, execution manager 150; Fig. 20);

c) processing said application request on the application server (col. 5 lines 6 - 15);

d) transmitting a response to the application request from the application server to the end user application, and converting the response to the application request from the language running on the application server to the first language of the first end user application (col. 5 lines 12- 17); and

e) wherein the connector comprises invocation metamodel data, application domain interface metamodel data, transaction message metamodel data, and type descriptor metamodel data (col. 4 lines 30 - 36; col. 5 lines 2 - 12, 39 - 50), wherein the connector is configured to (i) convert the application request from the first language of

Art Unit: 2194

the first end user application as a source language to the language running on the application server as a target language (col. 5 lines 6 - 12), and (ii) convert a response to the application request from the language running on the application server as a source language to the first language of the first end user application as a target language (col. 5 lines 13 - 16), each comprise:

- 1) invoking connector metamodels of respective source language and target language ("mapping file" col. 5 lines 6 - 15);
- 2) populating the connector metamodels with metamodel data of each of the respective source language and target language, the metamodel data comprising screen formatting for applications (col. 4 lines 26 – 36; col. 16 lines 21 – 37), the metamodel data of the target language including a map, a mapset, and a mapfield (Figures 3 and 10; col. 5 lines 29 - 48; col. 9 lines 10 - 22); and
- 3) converting the source language to the target language (col. 9 lines 10- 22).

11. Ben-Shachar fails to specifically disclose a mapping support language, a web server and connector, metamodel details, 3270, 3270 terminals and an audible alarm as claimed. However, Deborin discloses a mapping support language (p. 139 ¶ 1) and a BMS map, mapset, mapfield and attributes (§6.1; p. 158 2<sup>nd</sup> “●”). Deborin also discloses a web server as claimed (Figs. 17 and 18; §1.4).

12. Deborin also discloses wherein the connector comprises invocation and transformation capabilities, wherein the connector comprises a language metamodel to define data structures that represent connector interfaces, wherein the language metamodel indicates a source language, a target language, and a mapping between the source language and the target language, wherein the language metamodel comprises declaration text that is not editable, wherein the connector comprises a type descriptor metamodel that is language neutral and that defines a physical realization, a storage mapping, and a plurality of constraints, wherein the type descriptor metamodel provides a physical representation of individual fields of a given data structure, wherein the type descriptor metamodel provides data types mapping between languages (Figs. 17 – 21; §1.3; 1.4; 1.5; 5.1.1; 5.4.5.2; 6.1).

13. Deborin also discloses 3270 screen formatting for applications (§3.2 ¶ 1) and the BMS attributes comprise a control attribute that defines characteristics of 3270 terminals, and an alarm attribute that activates a 3270 audible alarm (p. 278 ¶3; p. 281 – 282, specifically, “ALARM” at the top of page 282).

14. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to combine these references because both references focus on providing server processing to clients by mapping requests between formats of the client and server.



15. As to claim 13, Deborin teaches the connector uses BMS metadata for interpretative marshalling (p. 139 ¶1).
16. As to claim 14, Deborin teaches the connector uses adapters (Fig. 17, plugin).
17. As to claims 15 – 17, see the rejection of claims 1, 13 and 14.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NATHAN PRICE whose telephone number is (571)272-4196. The examiner can normally be reached on 6:00am - 2:30pm, Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An can be reached on (571) 272-3756. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2194

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Meng-Ai An/  
Supervisory Patent Examiner, Art Unit 2195

NP